UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,784	03/18/2004	James Moore	241	8038

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PATENT DEPARTMENT
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EXAMINER
MORAN, RANDAL D

ART UNIT	PAPER NUMBER
2135	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/803,784	MOORE ET AL.
Office Action Summary	Examiner	Art Unit	
	Randal D. Moran	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25,28-50 and 53-56* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25,28-50 and 53-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *8/14/2007*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   The Information Disclosure Statement filed 8/14/2007 has been seen considered

by the examiner.

2.   Claims 1-25, 28-50, 53-56 are pending in the application.

3.   This action is in response to amendment filed 6/26/2007.

4.   Below, Examiner has pointed out particular references contained in the prior

art(s) of record in the body of this action for the convenience of the applicant. Although

the specified citations are representative of the teachings in the art and are applied to

the specific limitations within the individual claims, other passages and figures may

apply as well. Applicant should consider the entire prior art as applicable as to the

limitations of the claims. It is respectfully requested from the applicant, in preparing

the response, to consider fully each reference in its entirety as potentially teaching all or

part of the claimed invention, as well as the context of the passage as taught by the prior

arts or disclosed by the examiner.

Claim Objections

1.   **Claims 33 and 37** are objected to under 37 CFR 1.75(c), as being of improper

dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form.

- **Claim 33** contains all the limitations and has the same scope as preceding

  Claim 32.

- **Claim 37** contains all the limitations and has the same scope as preceding

  Claim 36.

2.   Objections to **Claims 10, 11, 40, and 41** in view of applicant arguments filed

6/26/2007.

Claim Rejections - 35 USC § 112

1.   The rejection of **Claim 3** is withdrawn in view of amendment filed 6/26/2007.

Claim Rejections - 35 USC § 101

1.   The rejection of **Claims 1-25, 28-50, and 53-56** is withdrawn in view of

amendment filed 6/26/2007.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   **Claims 1-15, 17-23, 28, 29, 34, 38-50, 53-56** are rejected under 35

U.S.C. 102(b) as being anticipated by **Peled et al. (US 2002/0087885)**, hereafter

"Peled".

3.   Peled was submitted by the applicant in an IDS filed on 8/26/2004.

4.   Considering **Claims 1 and 34,** Peled discloses a system for interdicting

unauthorized copying in a decentralized network ([0002]) comprising: one or

more computers having a plurality of software agents masquerading as nodes in a

decentralized network ([0035], [0099] lines 5-8, Fig. 2- item 16); and one or

more second computers having a query matcher ([0101] lines 1-5, Fig. 1- item 18)

that receives search results from the plurality of software agents ([0020]), and

reports matches of the search results with protected files back to the plurality of

software agents ([0021]) so that the software agents can interdict unauthorized

copying of the protected files in the decentralized network ([0041], [0096] lines

36-41, [0118] lines 4-6).

5.   Considering **Claim 2,** Peled discloses the plurality of software agents

communicate with the decentralized network through assigned ports ([0032],

[0078] lines 3-8, [0122]).

6.   Considering **Claim 3,** Peled discloses the assigned ports have corresponding IP

addresses that change in a manner so as to deter detection of the plurality of

software agents as unauthorized masqueraders of nodes in the decentralized

network ([0112] lines 4-12, [0130] lines 6-10, disguising messages as being from a

spoof server makes detection of the surveillance elements difficult).

7.   Considering **Claim 4,** Peled discloses the number and geographical locations of

the one or more first computers is determined by the number and geographical

distribution of nodes in the decentralized network ([0033], [0039]).

8.   Considering **Claim 5,** Peled discloses the one or more second computers has a

database including metadata for the protected files ([0021], [0025]).

9.   Considering **Claim 6,** Peled discloses a central coordinating authority

coordinating activities of the plurality of software agents so as to interdict

unauthorized copying in the decentralized network ([0033], [0039]).

10.   Considering **Claim 7,** Peled discloses the central coordinating authority sends

instructions to the plurality of software agents specifying actions to be taken

when the plurality of software agents receive matches of the search results with

protected files back from the query matcher ([0050], [0058], [0096] lines 31-33).

11.   Considering **Claims 8 and 38,** Peled discloses the instructions sent by the

central coordinating authority include an instruction to generate modified search

results (i.e. specifying actions) by deleting at least a subset of references

corresponding to the matches of the search results, and forward the modified

search results through the decentralized network ([0050], [0058], [0096] lines

31-33, [0130] lines 3-6, deleting messages that contain the protected content

would remove the protected content from the search results before they are

returned to the network).

12.   Considering **Claims 9-11 and 39-41,** Peled discloses the instructions sent by

the central coordinating authority include an instruction to generate modified

search results by modifying at least a subset of references corresponding to the

matches of the search results so as to point to one or more IP addresses that are

invalid, and forward the modified search results through the decentralized

network ([0118] lines 4-6, [0119] lines 7-9).

13.   Considering **Claims 12 and 42,** Peled discloses the instructions sent by the

central coordinating authority include an instruction to generate modified search

results by modifying at least a subset of references corresponding to the matches

of the search results so as to point to alternative files, and forward the modified

search results through the decentralized network ([0118] lines 4-9).

14.   Considering **Claim 13,** Peled discloses the alternative files include at least one

randomly selected file residing on a node upon which one of the matches of the

search results resides ([0118] lines 4-9).

15.   Considering **Claims 14 and 43,** Peled discloses the alternative files include at

least one decoy file residing on a host node controlled by the central coordinating

authority ([0118] lines 4-9, [0120] lines 7-14).

16.   Considering **Claim 15,** Peled discloses the alternative files include at least one

randomly selected file residing on a host node controlled by the central

coordinating authority ([0118] lines 4-9).

17.   Considering **Claims 17 and 45,** Peled discloses the instructions sent by the

central coordinating authority include an instruction to send an alternative file to

a client node when a request for a protected file is received from the client node

([0118] lines 4-17).

18.   Considering **Claims 18 and 46,** Peled discloses the alternative file is a decoy

([0118] lines 4-9, [0119] lines 7-13).

19.   Considering **Claims 19-23, 47, and 49,** Peled discloses the decoy is an audio

file containing white noise, the decoy is a video file containing white noise, the

decoy is an application containing a NOP executable that terminates the

application when executed, the decoy is an image file containing snow, the decoy is a document with blank contents ([0118] lines 4-9, [0019] lines 7-13).

20.   Considering **Claims 28, 53, and 54,** Peled discloses the instructions sent by the central coordinating authority include an instruction to modify at least one reference corresponding to a match in the search results so as to point to a non-existent file along with a reported hash value that does not correspond to any file in the decentralized network instead of the at least one reference ([0024], [0096] lines 19-41, [0120] lines 7-14).

21.   Considering **Claims 29 and 55,** Peled discloses the instructions sent by the central coordinating authority include an instruction to modify a reference corresponding to a match in the search results so as to point to a spoof file instead of the reference and report a hash value matching that of the reference even though the contents of the spoof file do not exactly match that of the reference ([0096] lines 19-41, [0120] lines 7-14).

22.   Considering **Claim 56,** Peled discloses one of the communications is a request to one of the plurality of software agents from a client node for at least a segment of a protected file ([0128], [0129]), and the interdicting of unauthorized copying comprises: transmitting data to the client node in response to the request so that a corrupted file is detected upon completion of downloading of the protected file to the client node ([0118] lines 4-6, [0120]).

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 16, 24, 25, 30-33, 35-37, 44, and 48** are rejected under 35 U.S.C.

103(a) as being unpatentable over **Peled** in view of **Schmelzer (WO 02/082271)**,

hereafter "Schmelzer".

3.   Schmelzer was presented by the applicant in an IDS filed on 6/29/2005).

4.   Considering **Claims 16, 25, 44 and 50,** Peled does not explicitly disclose the

alternative files include at least one rights-managed version of the matches.

Schmelzer does explicitly disclose the alternative files include at least one rights-

managed version of the matches (p.13- lines 14-20 and 26-31, p. 15- lines 15-19,

Fig. 20, Fig. 21).

Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to modify the teachings of Peled by responding

to request for protected content by directing the user to a rights-managed version

of the data as taught by Schmelzer in order to provide a reliable and secure

system for enabling intellectual property owners to distribute digital materials

while preventing infringement of intellectual property rights (Schmelzer- p. 5-

lines 8-10). It is of great interest to find a method that may stop or at least reduce

copyright infringement without interfering with the lawful use of file sharing

systems (Peled- [0003] lines 6-9)

5.   Considering **Claims 24 and 48,** Peled does not explicitly disclose the decoy

contains an anti-piracy message. Peled does suggest discouraging the user from

using the source again by transmitting content that does not satisfy the user

([0118] lines 4-17). This could be read as an anti-piracy message.

The combination of Peled and Schmelzer discloses the decoy contains an anti-

piracy message (Schmelzer- p.13- lines 14-20 and 26-31, p.15- lines 15-19, Fig. 1,

Fig. 2).

6.   Considering **Claims 30, 31, and 35,** the combination of Peled and Schmelzer

discloses the decentralized network is an hierarchical network with supernodes

and regular nodes (Schmelzer- p. 7- lines 14-19, the supernodes in the network

would be routers having content recognition capability, Peled- Fig. 3, Fig. 4,

[0035], the surveillance elements act as servers with the capability to allow them

to obtain data of documents on the system for search functionality, these

elements act as the supernodes), and the plurality of software agents masquerade

as regular nodes that inform their respective supernodes that they have copies of

protected files and claim node attributes so that the plurality of software agents

will be selected as top matches by their respective supernodes for search strings

indicating the protected files (Peled- [0033], [0038]-[0041]).

7.   Considering **Claims 32, 33, 36 and 37,** the combination of Peled and

Schmelzer discloses the decentralized network is an hierarchical network with

supernodes and regular nodes (Schmelzer- p. 7- lines 14-19, the supernodes in

the network would be routers having content recognition capability, Peled- Fig. 3,

Fig. 4, [0035], the surveillance elements act as servers with the capability to allow

them to obtain data of documents on the system for search functionality, these

elements act as the supernodes), and the plurality of software agents inform the

decentralized network that they are supernodes according to the protocol of the

decentralized network (Peled- [0033], [0038]-[0041], [0122]).

Response to Arguments

1.   Applicant's arguments filed 6/26/2007 have been fully considered but they are

not persuasive.

2.   Regarding **Claim 1,** applicants arguments have been fully considered but they

are not persuasive. With respect to applicants argument that Peled fails to disclose *the*

software agents reside on one or more first computers and the query matcher resides

on one or more second computers. Examiner disagrees and directs the applicant to

Peled: [0099], [0101], [0107], [0135], Fig. 3. "It is appreciated that certain features of

the invention, which are for clarity, described in the context of separate embodiments,

may be provided in combination in a single embodiment." Peled discloses "a first

surveillance element is a network application that appears as a regular agent or client."

Peled further discloses "second surveillance elements perform a search that is based on

an analysis of data being transported, for example query data, between other elements

in the network." A reasonable interpretation could be made that the second surveillance

elements (i.e. query matcher) receive and analyze data from the first surveillance

element (i.e. software agent). Peled further discloses "the second surveillance elements

preferably use high speed computers" which is consistent with the instant application.

With respect to applicants argument that Peled fails to disclose *interdiction of*

unauthorized copying is not performed by the first surveillance elements. Examiner

disagrees and directs the applicant to Peled: [0096], [0135]. . "It is appreciated that

certain features of the invention, which are for clarity, described in the context of

separate embodiments, may be provided in combination in a single embodiment."

Peled discloses "the above elements <u>may</u> be physically separated". Therefore, it is

taught by Peled that the interdiction is performed within the first surveillance elements.
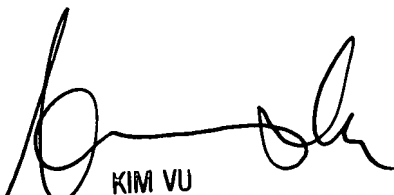
Conclusion

1.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Randal D. Moran whose telephone number is 571-270-

1255. The examiner can normally be reached on M-F: 7:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randal D. Moran
/RDM/

9/7/2007

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